UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte NICHOLAS H. DES CHAMPS

Appeal No. 2005-1936
Application No. 09/864,198

ON BRIEF

Before FRANKFORT, McQUADE and NASE, Administrative Patent Judges.
McQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Nicholas H. Des Champs appeals from the final rejection (mailed December 23, 2004) of claims 1 through 17, all of the claims pending in the application.

THE INVENTION

The invention relates to a scrap reduction procedure.

Representative claim 1 reads as follows:

1. A scrap reduction procedure comprising:

providing a repository for collecting information on materials, sizes and thicknesses available by first fabrication parties;

providing a repository for collecting information on materials, sizes and thickness needs of second user parties;

providing a means for communicating said materials, sizes, and thicknesses available to said second user parties and said materials, sizes, and thicknesses needed to said first fabrication parties to each other;

providing a means for receiving responses to said materials, sizes, thicknesses available from said first fabrication parties and said materials, sizes, thicknesses needed by said second user parties;

communicating said responses to an appropriate said first party or said second party.

THE REJECTION

Claims 1 through 17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication 2001/0049634 to Stewart in view of Official Notice by the examiner that it was old and well known in the art at the time of the invention that selling products that are available and saleable is a prudent method of reducing scrap.

Attention is directed to the main and reply briefs (filed January 24, 2005 and May 9, 2005) and answer (mailed April 18, 2005) for the respective positions of the appellant and examiner regarding the merits of this rejection.

DISCUSSION

I. The examiner's rejection

The record in the instant application shows that:

a) the examiner entered the rejection at bar for the first time in the final rejection;

b) the examiner subsequently conceded that the finality of this rejection was premature and the result of inadvertent error (see the advisory action mailed May 24, 2005);

c) the appellant seasonably challenged the Official Notice by the examiner in the main brief, and then again in the reply brief; and

d) the examiner did not advance evidentiary support for the Official Notice in response to the appellant's challenge as required by MPEP § 2144.03.

In light of the foregoing, we shall not sustain the standing 35 U.S.C. § 103(a) rejection of claims 1 through 17. In short, the factual basis proffered to support the rejection is fatally

flawed due to the examiner's failure to substantiate the Official Notice disputed by the appellant.

II. Remand to the examiner

On return of the application to the technology center, the examiner should reconsider the patentability of the subject matter recited in claims 1 through 17 in view of Stewart, considered alone or in conjunction with any other properly documented prior art, and enter appropriate rejections if such are warranted. By way of example, and notwithstanding the appellant's bald assertions to the contrary, the examiner's determination that Stewart teaches, or would have suggested, the five process steps set forth in independent claim 1 is reasonable on its face. Moreover, the recitation in the preamble of claim 1 that the claimed process is a "scrap reduction procedure" is quite broad and arguably finds response in Stewart's teaching that the interactive buying and selling method disclosed therein can be used to dispose of excess inventory (see paragraph 0083) and scrap products (see paragraph 0093). The appellant's position that the preamble requires more appears to rest on an improper attempt to read limitations from the specification into the claim.

SUMMARY

The decision of the examiner to reject claims 1 through 17 is reversed, and the application is remanded to the examiner for further consideration.

REVERSED AND REMANDED

CHARLES E. FRANKFORT)
Administrative Patent Judge)
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JOHN P. McQUADE) BOARD OF PATENT
Administrative Patent Judge) APPEALS
) AND
) INTERFERENCES
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JEFFREY V. NASE)
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